

Applicants submit that the amendments do not change the scope of the disclosure and that the amendments merely place the specification in better condition for issuance.

The preliminary amendment to the specification at page 8, line 16, corrects an administrative error which is supported by Claim 1, page 149, line 15 and by Example 94, page 115, line 2, in which R¹² must be C₁ alkyl substituted methylene to correspond to the exemplified compound.

Applicants respectfully submit that Claims 1-40 are not obvious within the meaning of 35 U.S.C. § 103 and request reconsideration for the following reasons.

Obligation Under 37 C.F.R. § 1.56

The Examiner properly presumes that the subject matter of the various claims was commonly owned at the time of the inventions covered therein. Applicants are joint inventors. Buddy Cantrell and Dennis Zimmerman were employed by Eli Lilly and Company during the period of their work on the present invention. Research scientists at Eli Lilly and Company do not sign an employment contract; however, they understand that they are under an obligation to assign all inventions to Eli Lilly and Company which are made in the course of employment. As such, the present invention was commonly owned by Eli Lilly and Company at the time of all inventions covered by this application.

Rejection Under 35 U.S.C. § 103

The Examiner has rejected all pending claims under 35 U.S.C. § 103 as being unpatentable over Zimmerman (450) in view of Zimmerman (635). Zimmerman (450) teaches 1,3,4-trisubstituted-4-aryl piperidines; however Zimmerman (450) does not teach carboxylic acid containing derivatives. Zimmerman (635) discloses 1,2,4,5-tetra-alkyl-4-aryl piperidines with N-substituted 1-piperidine substituents, including alkyl, and the acid addition salts of the compound. Examiner Covington suggests that the carboxylic acid addition salts of Zimmerman (635) viewed with Zimmerman (450) would lead the skilled artisan to prepare the compounds of the present invention. Applicants courteously disagree.

Applicants respectfully assert that the carboxylic acid salts are both physically and pharmacologically distinct from the compounds of the present invention. Indeed, one feature of this invention is a carboxyl group covalently bonded to an alkyl at the 1-position of the piperidine. The covalently bonded carboxyl group is stable and pharmacologically distinct from the carboxylic acid salt compounds of Zimmerman (635). The carboxylic acid salt of Zimmerman (635) dissociates to the free base having an alkyl substituent. Applicants submit that the free bases of the compounds prepared using the teachings of Zimmerman (450) in light of Zimmerman (635) are different and patentably distinct from the compounds of the present invention.

Additionally, this invention provides compounds in which the 1-position substituent of the piperidine may terminate in an ester or amide group. None of the pertinent art suggests such substituents. Applicants believe that the artisan would not be motivated to prepare the ester and amide substituents of the instant invention based on the teachings of Zimmerman (635) which merely allows for pharmaceutically acceptable salts of a piperidine which is N-substituted with an alkyl group.

The teachings of Zimmerman (635) do not suggest the preparation of covalently bonded carbonyl substituent. While Zimmerman (450) teaches certain trisubstituted aryl piperidines, it does not lead the artisan to attach the substituents of this invention. Applicants submit that there is no suggestion or disclosure of the compounds of the instant invention in which the 1-position of piperidine is substituted with an alkyl group terminating in a covalently bonded carboxylic acid, ester, or amide. Therefore, Applicants request removal of the rejection under 35 U.S.C. § 103.

Applicants respectfully request entry of the amendment submitted on October 19, 1992. For all of the foregoing reasons, Applicants respectfully request favorable reconsideration, allowance of all pending claims, and passage of the application to issue.

Respectfully submitted,



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January 20, 1993
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